

Nalco Docket No.: 7560-NES
Customer No. 000049459

OFFICIAL

REMARKS

This is in reply to the Office Action mailed on May 28, 2008 ("Office Action").

Claims 4-14, 16-28, 30, 31, 33-40, 42-53 and 55-63 are currently pending.

Claims 42-46, 48, 52 and 55-60 are allowed.

Claims 24, 25, 37 and 39 are objected to as being dependent on a rejected base claim.

Claims 4, 6-14, 16-26, 38, 40, 47, 53 and 63 are rejected under 35 U.S.C. § 112, second paragraph.

Claims 4, 5, 16-23 and 60-63 are rejected under 35 U.S.C. § 102(b) over U.S. 5,324,404 ("Ott").

Claims 4, 6-10, 18-23, 26-28, 30-31 and 33-36 are rejected under 35 U.S.C. § 103(a) over U.S. 5,324,404 ("Ott").

Claims 4-27, 30, 31, 38, 40, 51-53, 61-63 are cancelled without prejudice to reduce the matters at issue.

Claim 28 is amended to particularly point out and distinctly claim subject matter which Applicant regards as his invention. More particularly, claim 28 is claims 37 and 39 drafted in independent format and incorporating all of the limitations of the base claims and any intervening claims.

Claims 33-39 are cancelled and their subject matter is incorporated into amended claim 28.

No new matter is added by this amendment.

Nalco Docket No.: 7560-NES
Customer No. 000049459

OFFICIAL

DISCUSSION

The Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 4, 6-14, 16-26, 47, 53 and 63 are rejected under 35 U.S.C. § 112, second paragraph.

Applicant respectfully traverses this rejection.

Claims 4, 6-14, 16-26, 53 and 63 are cancelled, rendering the rejection of these claims moot.

With regard to claim 47, applicant respectfully asserts that the alkyleneoxide copolymers, oxyalkylated alcohols, organo-phosphate esters, inorganic phosphate esters, polyglycols, resole resins and novalac resins recited therein are not reactants used in the preparation of the claimed oligo- and polymeric reaction products but rather additional ingredients that can be formulated with the polymers to enhance the properties of the demulsifier composition. See specification at page 12, line 29 to page 13, line 26. Applicant further respectfully asserts that this is evident in that the recited additional components all fall outside the description of the reactants used to prepare the polymeric reaction products. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 47 under 35 U.S.C. § 112, second paragraph.

The Rejection of Claims 4, 5, 16-23 and 60-63 are rejected under 35 U.S.C. § 102(b) over U.S.

5,324,404

Claims 4, 5, 16-23 and 60-63 are rejected under 35 U.S.C. § 102(b) over U.S. 5,324,404 ("Ott").

Applicant has cancelled claims 4, 5, 16-23 and 60-63, rendering this rejection moot.

The Rejection of Claims 4, 6-10, 18-23, 26-28, 30-31 and 33-36 under 35 U.S.C. § 103(a) over U.S.

5,324,404

Claims 4, 6-10, 18-23, 26-28, 30-31 and 33-36 are rejected under 35 U.S.C. § 103(a) over U.S. 5,324,404 ("Ott").

Applicant has cancelled claims 4, 6-10, 18-23, 26, 27, 30-31 and 33-36 rendering the rejection of these claims moot.

Nalco Docket No.: 7560-NES
Customer No. 000049459

OFFICIAL

As noted above, amended claim 28 corresponds to original claims 37 and 39 which the Examiner indicated would be allowable if rewritten in independent form to include the limitations of the base claim and any intervening claims. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 28 under 35 U.S.C. § 103(a) over Ott.

Nalco Docket No.: 7560-NES
Customer No. 000049459

OFFICIAL

CONCLUSION

Applicant respectfully requests entry of the foregoing amendment which cancels rejected claims and redrafts claims which are objected to place in condition for allowance. Applicant therefore respectfully requests withdrawal of the rejections under 35 U.S.C. §§ 112, second paragraph, 102(b) and 103(a) and respectfully assert that this application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully submitted,



Michael B. Martin, Reg. No. 37,521
Nalco Company
Patent & Licensing Department
1601 W. Diehl Road
Naperville, IL 60563-1198

Date: 9/29/08